

REMARKS/ARGUMENTS

Favorable reconsideration and allowance of the present application is respectfully requested. Claims 1, 2 and 4-23 are pending in the above application of which claims 1 and 22 are independent. Claim 23 has been added by the above amendment.

The Office Action dated August 3, 2010, has been received and carefully reviewed. In that Office Action, claims 10 and 22 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite, claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-43927, and claims 1, 2, 4-6, 9, 14 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-43927 in view of Sodec. Claims 8, 10-13 and 15-20 were objected to for being dependent upon rejected base claims, but were indicated to be allowable if amended to include the limitations of their base claims. It is believed that all claims are allowable over the art of record, and reconsideration and allowance of claims 1, 2, 4-7, 9, 14, 21 and 22 and allowance of claims 1, 2 and 4-23 are respectfully requested in view of the above amendments and the following remarks.

ALLOWABLE SUBJECT MATTER

Claims 8, 10-13 and 15-20 are indicated to be allowable if amended to include the limitations of their base claims. It is believed that all claims are allowable over the art of record, and therefore these claims are not being rewritten in independent form at this time.

REJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH

Claim 10 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The antecedent basis issue identified by the examiner has been addressed by the above amendment.

Claim 22 was rejected under 35 U.S.C. 112, second paragraph, because there was said to be no antecedent basis for the phrase "the air conditioning device" in line 2. It is respectfully submitted that the phrase "the air conditioning device" does not appear in claim 22. Rather, line 2 of claim 22 recites "the air conduction device," and "an air conduction device" is recited in line 1. Furthermore, the phrase "the air conditioning device" does not appear elsewhere in the claims. The rejection of claim 22 under 35 U.S.C. 112, second paragraph is therefore respectfully traversed.

REJECTIONS UNDER 35 U.S.C. 103(a)

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-043927. Claim 22 recites, inter alia, an air vent with an air conduction device and an air-supplying air duct in the air conduction device. The air duct is divided into at least two essentially cylindrical subducts each having a centerline, and the centerlines of the at least two essentially cylindrical subducts are mutually parallel over their entire lengths. As acknowledged in the Office Action, the "subducts" 19, 21 and 23 of JP 63-043927 are not essentially cylindrical. However, the Office Action asserts that it would have been obvious to make these elements essentially cylindrical. Several statements are provided in the Office Action to justify this modification. It is respectfully submitted, however, that a proper reason for modifying JP 63-043927 has not been provided and

furthermore, that the proposed modification appears to change the principle of operation of JP 63-043927 and to render JP 63-043927 unsatisfactory for its intended purpose. Such modifications are never obvious pursuant to MPEP 2143.01. Each of these issues is addressed below.

The Office Action first argues that making the somewhat conical subducts of JP 63-043927 essentially cylindrical is obvious as a matter of "design choice." The phrase "design choice" appears in MPEP 2144.01 in connection with a discussion of a "rearrangement of parts." The modification proposed in the Office Action is not a "rearrangement" of any parts. This language therefore does not support a rejection of claim 22. It is respectfully requested that, if the rejection of claim 1 is maintained, that the examiner identify the legal basis for calling a modification an obvious "design choice" when the modification is not a rearrangement of parts.

The Office Action also indicates that Applicant has not disclosed what problem is solved by the use of a cylindrical duct. It is respectfully submitted that there is no requirement that each limitation of a claim "solve a problem." The size and shape of air ducts affects the characteristics of the air flowing through and from air ducts. Many patents in the vehicle arts are directed to specific shapes and arrangements of ducts to provide desirable air flow characteristics and to improve the comfort of vehicle occupants. The shape of Applicant's duct affects the airflow therethrough and is not merely aesthetic, and the lack of a specific problem solved by the claim of a cylindrical duct does not provide a basis for rejecting claim 22.

The Office Action also cites MPEP 2144.04 (IV)(B) in support of the rejection. This MPEP section, related to changes in shape, discusses *Application of Donald E.*

Dailey, 357 F.2d 669 (CCPA 1966), a case in which a change to the shape of a collapsible baby bottle had no effect on the operation of the bottle. A minor change in shape that did not affect the function of the bottle in any manner was held to be obvious. As discussed above, the change proposed to JP 63-043927 would affect the operation and performance of the device disclosed in JP 63-043927, and the *Dailey* case is therefore inapposite and does not support the rejection of claim 22.

If the rejection of claim 22 is maintained, it is respectfully requested that the examiner explain how the *Application of Donald E. Dailey* case is relevant to the present rejection and/or explain how a change that affects the operation and performance of a reference can be treated as a mere “change in shape.”

The Office Action further indicates that JP 63-043927 would perform “equally well” and would “transfer air” equally well if modified to have cylindrical subducts. No basis for this assertion is provided in the record. If the examiner is taking Official Notice regarding the performance of various ducts or basing the rejection on personal knowledge, it is respectfully requested that the requirements of MPEP 2144.03 be satisfied. Otherwise, it is submitted that changing the shape of the subducts in JP 63-043927 will affect airflow through these ducts and the way air is output from the ducts. There is no evidence in the record to show that this modified design would perform “equally well” as the original design as asserted in the Office Action.

If the rejection of claim 22 is maintained, it is respectfully requested that the examiner provide the reasoning behind the assertion that the proposed modification to JP 63-043927 will result in a vent that performs “equally well” as the device disclosed in JP 63-043927. It is believed this explanation will require an explanation regarding how

the device in JP 63-043927 performs and an explanation regarding how the performance of the modified device is "equal" thereto.

It is also respectfully submitted that the proposed modification to JP 63-043927 would impermissibly change the principle of operation of that reference. JP 63-043927 shows four subducts that increase in diameter in the direction of airflow and that output a given pattern of airflow. Figure 2 of this reference shows what appear to be movable vanes that fit in the duct opening for guiding air therein. If the shape of the subducts were modified, air would flow in a different direction and/or at a different rate and be affected in a different manner by the vanes. The change proposed by the examiner changes the way the device in JP 63-043927 operates, and it appears that the change will affect the principle of operation of the device in JP 63-043927. Such changes are not obvious according to MPEP 2143.01. The modification that is being proposed to JP 63-043927 is submitted to be non-obvious for this reason as well, and claim 22 is submitted to be allowable over JP 63-043927 for at least these reasons.

New claim 23 depends from claim 22 and is submitted to be allowable for at least the same reasons as claim 22. Claim 23 further recites that the air duct includes a centerline and that a portion of the air duct centerline near the at least two essentially cylindrical subducts is parallel to the centerlines of the at least two essentially cylindrical subducts. The centerlines of the subducts in JP 63-043927 are not parallel to the centerline of any duct leading up to that subduct, and claim 23 is submitted to further distinguish over JP 63-043927 for this reason.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-043927 in view of Sodec. Claim 1 recites an air vent with an air-supplying air duct and

with an air conduction device, the air duct in the air conduction device being divided into at least two essentially cylindrical subducts. The cylindrical subducts are arranged parallel with respect to one another, and at least one further subduct is provided around at least one of the cylindrical subducts. The Office Action is proposing to replace subducts in JP 63-043927 that are not essentially cylindrical with subducts that are essentially cylindrical. As discussed above in connection with claim 22, a proper reason for making such a modification to JP 63-043927 has not been provided. Sodec provides no reason to modify JP 63-043927 in this manner. Claim 1 is therefore submitted to be allowable for the reasons provided above in connection with claim 22.

The rejection of claim 1 also fails to satisfy the requirements of *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) because it contains no reason for making the proposed change to JP 63-043927. As opined by the court in KSR:

“[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit (emphasis added).”

JP 63-043927 is in Japanese and does not include an English language abstract or title. It cannot be determined from the record what problem the inventor of this reference was attempting to solve, what benefits the invention was intended to provide or what problems remained unsolved. It is possible that JP 63-043927 discloses a ventilation system for an automobile, but even this is not conclusively shown by the record. With all these unknowns, the Office Action asserts that one of ordinary skill of the art would have replaced one of the subducts of JP 63-043927 with a vent designed

to circulate stagnant air in the freezer aisles of a grocery store. The record contains no articulated reasoning to show why one of ordinary skill in the art would have made the proposed change. Claim 1 is submitted to be allowable over the art of record for this reason as well.

If the rejection of claim 1 is not withdrawn, it is respectfully requested that the examiner provide the "articulated reasoning" with a "rational underpinning" to support the legal conclusion of obviousness as required by *KSR International Co. v. Teleflex, Inc.* to show why one of ordinary skill in the art would have made this change. Specifically, this reasoning should explain what problem with JP 63-043927 an inventor would have been addressing by making the proposed modification and why the inventor would have looked to Sodec for a solution, given that JP 63-043927 does not appear to suffer from any problem related to stagnant air on the floor of a freezer aisle of a grocery store.

The Office Action also indicates that the proposed modification to JP 63-043927 would have "predictable results." However, these "results" are not identified. If the rejection of claim 1 is not withdrawn, it is respectfully requested that the examiner explain for the record what these predictable results are; that is, how the operation of JP 63-043927 would change with the modification being proposed.

In addition, it is respectfully submitted that a proposed modification is not obvious if it changes the principle of operation of the primary reference or renders the primary reference unsatisfactory for its intended purpose. MPEP 2143.01. It appears that the proposed modification to JP 63-043927 will change the shape of the airflow from ducts 19, 21, 23, and 25 and thus remove whatever benefit the inventor of JP 63-

043927 was attempting to provide with the disclosed arrangement. Furthermore, if the intended purpose of JP 63-043927 was to provide air flows having a particular character, the change proposed by the Office Action will also render JP 63-043927 unsatisfactory for this purpose. Modifications that change the principle of operation of a primary reference and modifications that render a primary reference unsatisfactory for its intended purpose are not obvious, and claim 1 is submitted to be allowable over JP 63-043927 and Sodec for these reasons as well.

Claims 2 and 4-21 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

CONCLUSION

Each issue raised in the Office Action dated August 3, 2010, has been addressed, and it is believed that claims 1, 2 and 4-23 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited. If the examiner believes that any additional changes would place the application in better condition for allowance, the examiner is invited to contact the undersigned attorney at the telephone number listed below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-3828 and please credit any excess fees to such deposit account.

Respectfully submitted,



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Date: September 27, 2010